

REMARKS

This Application has been carefully reviewed in light of the Office Action dated January 22, 2007 (the “Office Action”). At the time of the Office Action, Claims 1-45 are pending in the Application and Claims 10-34 are withdrawn. The Examiner rejects Claims 1-9 and 35-45. Applicant amends Claims 1 and 8 and adds new Claim 46. As described below, Applicant believes all claims to be allowable over the cited references. Therefore, Applicant respectfully requests reconsideration and full allowance of all pending claims.

Section 112 Rejections

The Examiner rejects Claims 1-9 and 35-45 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner states that the phrase “receiving an electronic selection, by the consumer” should be replaced with “receiving an electronic selection, generated by the consumer.” Applicant has amended Claim 1 in the manner suggested by the Examiner. Accordingly, Applicant respectfully requests that the 35 U.S.C. § 112, second paragraph rejection be withdrawn.

Section 102 Rejections

The Examiner rejects Claims 1-7, 9, and 35-45 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2001/0032143 issued to Haseltine (“Haseltine”). Applicant respectfully disagrees.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987); MPEP § 2131. In addition, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claims” and “[t]he elements must be arranged as required by the claim.” *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); MPEP § 2131 (*emphasis added*). Whether

considered alone or in combination with any other cited references, *Haseltine* does not disclose, either expressly or inherently, each and every element of the claims.

For example, Applicant continues to submit that *Haseltine* does not disclose, suggest, or teach “displaying the transaction history associated with the identified consumer **to the consumer** on a computerized system, the transaction history identifying a listing of merchandise associated with the consumer” **wherein the consumer is “associated with the purchase of one or more items of merchandise,”** as recited in Claim 1. Rather, and as previously shown by Applicant, the very purpose of *Haseltine* is to provide a “**point-of-return associate**” at a third-party establishment for “walk-in processing” of a returned item.¹ In the Office Action, the Examiner states that “the associate in *Haseltine* is read as the agent of the customer which inherently is the alter ego of the customer.” (Office Action, page 3). However, it is irrelevant whether or not the associate of *Haseltine* is the agent/alter ego of the customer because Applicant has not claimed either “displaying the transaction history . . . to an agent of the customer” or “displaying the transaction history . . . to an alter ego of the customer.” Rather, Claim 1 clearly recites “displaying the transaction history associated with the identified consumer **to the consumer** on a computerized system, the transaction history identifying a listing of merchandise associated with the consumer” wherein the consumer is “associated with the purchase of one or more items of merchandise.” Because *Haseltine* does not disclose, teach, or suggest the recited claim elements, Applicant respectfully submits that

¹ Specifically, *Haseltine* states:

The point-of-return associate 42 provides walk-in processing of the primary target’s request for return. The point-of-return associate reads or otherwise enters the immediate message given by the inventive bar-coded packing slip 26. Again, the immediate message might actually be a web request for the download of the more full record of the packing slip. However gotten, the *point-of-return associate* calls up the electronic packing slip. Unlike most paper packing slips seen nowadays, this inventive electronic packing slip includes precise information if not instructions to the point-of-return associate. Such information or instructions will guide *this point-of-return associate* on how to properly authorize the return of the given product of this e-tailer.

Applicant's Claim 1 is patentable over *Haseltine* and the rejection of Claim 1 under 35 U.S.C. § 102 is improper.

As a further example, Applicant submits that *Haseltine* also does not disclose, teach, or suggest "**in response to and after displaying the transaction history, receiving an electronic selection**, by the consumer, of a particular item of merchandise within the listing of merchandise in the displayed transaction history, the electronic selection comprising input into the computerized system," as recited in Claim 1. In the Final Office Action, the Examiner states:

The consumer through its agent 42 is read as causing a selection to be received by the association server 30 or bureau 44, the selection is read as the item, see, e.g., paragraph [0040], the selection of POKEMON of the one e-tailer rather than the other e-tailer and the subsequent transmission of the selected one of the POKEMON devices for return.

(Office Action, page 3). The cited paragraph [0040] of *Haseltine* does indeed discuss an example where a child receives three identical copies of a POKEMON game toy for Christmas. (Page 4, paragraph 0040). In the provided example, the "child has brought in the two spare copies of the POKEMON game toy to the neighborhood point-of-return associate." (Page 4, paragraph 0040). Even if the selection of the two spare copies over third copy is, as the Examiner suggests, "an electronic selection, by the consumer, of a particular item of merchandise" (which Applicant does not admit), such a selection is not from a "displayed transaction history," as recited in Claim 1. The selection of the two spare copies over the third copy cannot be an electronic selection from a "displayed transaction history" since nothing has been displayed at this point in the *Haseltine* process. Accordingly, since *Haseltine* discloses that the item is not displayed until **after** the scanning of the selected packing slip, Applicant respectfully submits that *Haseltine* cannot be said to disclose, teach, or suggest "**in response to and after displaying the transaction history, receiving an electronic selection, by the consumer, of a particular item of merchandise within the listing of merchandise in the displayed transaction history**,

the electronic selection comprising input into the computerized system," as recited in Claim 1.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claim 1, together with Claims 2-7, 9, and 35-45 that depend from Claim 1.

Section 103 Rejections

The Examiner rejects Claims 1-9 and 35-45 under 35 U.S.C. § 103(a) as being unpatentable over *Haseltine* in view of U.S. Patent No. 6,321,211 issued to Dodd ("Dodd"). Applicant respectfully traverses these rejections for the reasons stated below.

The Proposed *Haseltine-Dodd* Combination is Improper

First, assuming for purposes or argument that the proposed combination discloses the limitations of Applicant's Claim 1 (which Applicant disputes below), it would not have been obvious to one skilled in the art to make the proposed *Haseltine-Dodd* combination. In the Final Office Action, the Examiner speculates that "it would have been obvious to modify the method of *Haseltine* to include the user driven self return process of *Dodd* and to provide a selection step, the motivation being the ability to return a product without the need of going to a third party and the ability to allow a user to choose the mode of return e.g. return exchange etc." (Final Office Action, page 5). Applicant respectfully submits, however, that the provided motivations do not provide a suggestion to combine these two references.

It is essential to view the invention as a whole, taking each element into account as well as the advantages, properties, utilities, and results of the invention. *In re Chupp*, 816 F.2d 643, 2 U.S.P.Q.2d 1437 (Fed. Cir. 1987). The mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). As discussed above, the very principle and purpose of the system disclosed in *Haseltine* is to provide "a distributed network of point-of-return affiliates who will accept the e-tailer's

returns on a walk-in basis in such associate's brick-and-mortar store." (Page 2, paragraph 18). In fact, the system of *Haseltine* is specifically formulated to compete with Wal-Mart and other retailers that have "a widely distributed infrastructure of brick-and-mortar stores." (*Haseltine*, paragraph 15). The system is designed as an answer to e-tailers "that don't allow consumers to return products to physical stores" or "accept the returns in person." (*Haseltine*, paragraph 11). Thus, the system of *Haseltine* is centered around the user of a brick-and-mortar store who provides a staffed service of returns providers. In contrast, the system of *Dodd* is designed to allow the recipient of an online gift the opportunity to select a replacement gift "prior to physically receiving the online gift" in an exchange transaction. (Column 2, lines 45-51). Thus, the very purpose of the *Dodd* system is to avoid situations where "the recipient still must receive the gift and physically return it when they are not satisfied with the gift." (Column 1, lines 47-49). Because the objectives of the *Dodd* and *Haseltine* systems are clearly inconsistent with one another, Applicant respectfully submits that one of ordinary skill in the art at the time of invention would not have been motivated to modify *Haseltine* in the manner proposed by the Examiner.

Furthermore, it is improper for an Examiner to use hindsight having read the Applicant's disclosure to arrive at an obviousness rejection. *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). It is improper to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). The inconsistencies in *Haseltine* and *Dodd*, as identified by Applicant above, evidences the Examiner's reconstruction of Applicant's claims by using hindsight to piece together disjointed portions of analogous, but inconsistent references.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claim 1, together with Claims 2-7 and 9 that depend from Claim 1.

The Claims are Allowable over the Proposed *Haseltine-Dodd* Combination

Second, even if the combination of *Haseltine* and *Dodd* is proper (which Applicant disputes above), Applicant continues to submit that the *Haseltine* and *Dodd*, do not disclose, teach, or suggest the elements recited in Applicant's claims. With regard to the Examiner's rejection of Claim 1 under 35 U.S.C. § 102(e), Applicant has provided a detailed discussion of *Haseltine* above. Specifically, Applicant has shown that *Haseltine* fails to disclose, teach, or suggest "**in response to and after displaying the transaction history**, receiving an electronic selection, generated by the consumer, of a particular item of merchandise within the listing of merchandise in the displayed transaction history, the electronic selection comprising input into the computerized system" and then "initiating a returns process in response to receiving the electronic selection," as recited in Claim 1. Applicant further submits that the disclosure of *Dodd* does not make up for the discussed deficiencies of *Haseltine*. Like *Haseltine*, *Dodd* also does not disclose, teach, or suggest "**in response to and after displaying the transaction history**, receiving an electronic selection, generated by the consumer, of a particular item of merchandise within the listing of merchandise in the displayed transaction history, the electronic selection comprising input into the computerized system" and then "initiating a returns process in response to receiving the electronic selection," as recited in Claim 1.

Dodd merely discloses a system and method that provide "the ability for an online gift recipient to accept or exchange an online gift prior to shipping the gift to the recipient." (Abstract). In particular, "[a]fter a gift has been selected and the gift giver has provided contact information for the recipient . . . , web server 433a typically sends a notification message to the recipient" of the online gift. (Column 9, lines 28-31). After receiving the notification, "[t]he recipient then connects to the gift server computer system 330 through the Internet 412 and either manually provides an identifier to the web server 433a or the web server 433a automatically determines the identifier that links or associates the recipient with the appropriate order information on the selected gift." (Column 9, lines 35-41). According to the disclosure of *Dodd*, the webserver then displays one or more webpages to the recipient, which provide the recipient with details associated with

the online gift and allow the recipient the options of accepting or exchanging the gift. (Column 9, lines 35-41; Column 11, lines 26-32; Figures 2A-2E). Thus, the recipient of an online gift merely clicks on one or more icons (Figure 2D, reference numeral 142; Figure 2E, reference numerals 144 and 145) to view the online gift and accept or exchange the online gift. By allowing exchange of a gift before it is received, *Dodd* actually seeks to eliminate the return of items altogether. Accordingly, there is no “in response to displaying the transaction history, receiving an electronic selection, by the consumer, of a particular item of merchandise within the listing of merchandise in the displayed transaction history, the electronic selection comprising input into the computerized system,” as recited in Applicant’s Claim 1.

Furthermore, *Dodd* explicitly discloses that the exchange system of *Dodd* is used by an online gift recipient “prior to shipping the gift to the recipient.” Accordingly, “[i]f the recipient wants to exchange the online gift for a replacement gift, the replacement gift is selected from a group of alternative gift items.” (Column 2, lines 6-9). “Once the replacement gift has been selected, an electronic order for the replacement gift is placed prior to physically receiving the online gift.” (Column 2, lines 10-12). *Dodd* provides such a system to avoid situations where “the recipient still must receive the gift and physically return it when they are not satisfied with the gift.” (Column 1, lines 47-49). Thus, the *Dodd* system actually teaches away from “in response to displaying the transaction history, receiving an electronic selection, by the consumer, of a particular item of merchandise within the listing of merchandise in the displayed transaction history, the electronic selection comprising input into the computerized system” and then **“initiating a returns process in response to receiving the electronic selection”** and then “initiating a returns process in response to receiving the electronic selection,” as recited in Claim 1.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claim 1, together with Claims 2-7 and 9 that depend from Claim 1.

Claim 8 has been rewritten in independent format. Independent Claim 8 recites the claim elements recited in Claim 1 prior to amendment in this Office Action (with the exception of the addition of “generated” as requested by the Examiner to obviate the 35 U.S.C. § 112 rejection). Because Claim 8 recites certain of the claim elements recited in Claim 1, Applicant submits that Claim 8 is allowable for the reasons discussed above with regard to Claim 1.

Additionally, it continues to be Applicant’s position that dependent Claim 8 recites elements that further distinguish the art. For example, Claim 8 recites “auctioning the merchandise selected for return by the consumer.” In the Office Action, the Examiner states that *Haseltine* discloses “the problem with returns is that the customer and client may be separated by the entire breadth of the country making shipping for small products e.g. cookies (paragraph 0026) non cost effective.” (Office Action, page 6). The examiner further states that “it would be an obvious choice to try to sell the product for the best possible price so as not to incur a total loss and the old and notorious way of effecting this is the use of an auction.” (Office Action, page 6).

Applicant respectfully submits that the Examiner misstates the disclosure of *Haseltine*. The portion of *Haseltine* relied upon by the examiner merely states that the “bar-coded packing slip is affixed by any suitable means to as much of the product that comprises a discrete, returnable unit.” (Page 2, paragraph 26). As an example, *Haseltine* provides that “if the returnable unit comprises a box of cookies, then it is the box and not the cookies which are affixed with the bar code.” (Page 2, paragraph 26). Thus, the portion of *Haseltine* relied upon by the Examiner merely indicates that the packing slip is attached to the box rather than to each individual cookie. There is no disclosure in paragraph 26 of “the problem with returns is that the customer and client may be separated by the entire breadth of the country making shipping for small products, e.g. cookies (paragraph 0026) non cost effective,” as maintained by the Examiner. The Examiner is reading details into *Haseltine* that simply are not there. Accordingly, the portion of *Haseltine* relied upon by the Examiner does not provide the suggestion or motivation to

modify *Haseltine* as the Examiner states. Certainly, *Haseltine* does not suggest that "it would be an obvious choice to try to sell the product for the best possible price so as not to incur a total loss and the old and notorious way of effecting this is the use of an auction," as suggested by the Examiner. There is simply no disclosure in *Haseltine* or *Dodd* of "auctioning the merchandise selected for return by the consumer," as recited in Claim 8, and it would not have been obvious to one of ordinary skill in the art at the time of Applicant's invention to make such a modification of *Haseltine* as proposed by the Examiner.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claim 8

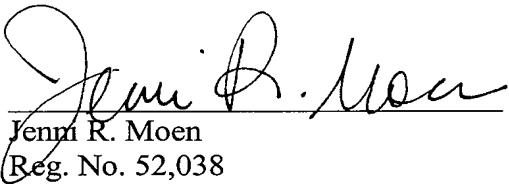
CONCLUSION

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Jenni R. Moen, Attorney for Applicant, at the Examiner's convenience at (214) 953-6809.

The Commissioner is hereby authorized to charge \$225.00 to Deposit Account No. 02-0384 of Baker Botts L.L.P. for additional claims. Applicant believes that no other fees are due; however, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
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